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U.S. Application No. 09/876,738
Appellant's Brief

PATENT
450100-03276

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant : Toyoaki KISHIMOTO
Serial No. : 09/876,738
For : INFORMATION-PROCESSING APPARATUS AND
INFORMATION-PROCESSING METHOD
Filed : June 7, 2001
Examiner : Tam T. Phan
Art Unit : 2144
Confirmation No. : 9194

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BRIEF OF APPELLANT

Mail Stop Briefs-Patents
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Dear Sir:

This is an appeal from the final rejection dated May 12, 2005, rejecting claims
1-19, all of the pending claims in the above-captioned application. A Notice of Appeal was filed

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on August 11, 2005. This Brief is submitted in triplicate and is accompanied by the requisite fee set forth in 37 C.F.R 1.17(c).

1. REAL PARTY IN INTEREST

The real party in interest is Sony Corporation, a Japanese corporation. This interest is the result of an assignment recorded at Reel/Frame: 012178/0486 recorded in the United States Patent and Trademark Office on September 19, 2001.

2. RELATED APPEALS AND INTERFERENCES

Upon information and belief, the undersigned attorney does not believe that there is any other appeal, or interference, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF THE CLAIMS

This application was filed with claims 1-19 on June 7, 2001.

An Office Action issued on November 3, 2004 rejecting claims 1-19 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,360,364 to Chen, et al. (hereinafter, merely "Chen") in view of U.S. Patent No. 6,393,470 to Kanevsky, et al. (hereinafter, merely "Kanevsky"). The Office Action also rejected claims 15-19 under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. Claims 1-19 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-23 of co-pending Application No. 09/862,656.

Appellant filed an amendment on January 31, 2005.

A Final Office Action issued on May 12, 2005, finally rejecting claims 1-19 under 35 U.S.C. §103(a) as allegedly unpatentable over Chen in view of Kanevsky in further view of U.S. Patent No. 5,617,518 to Kuwamoto, et al. (hereinafter, merely "Kuwamoto"). The Office Action also provisionally rejected claims 1-19 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-23 of co-pending Application No. 09/862,656 in view of Kuwamoto.

Appellant filed a response on July 7, 2005.

An Advisory Action was mailed on July 22, 2005, indicating that the Appellant's response would be entered because no new issues were raised.

Appellant filed a Notice of Appeal and fee on August 11, 2005.

Claims 1-19 are currently pending. Claims 1, 6, 8, 10, 13, 15 and 18 are independent. Claims 1-19 stand rejected in the Final Office Action mailed May 12, 2005.

4. STATUS OF AMENDMENTS

The After-Final Response was entered by the Examiner, as indicated in the Advisory Action dated July 22, 2005. However, no claims were amended in the After-Final Response. The claims as set forth in the Appendix include all previously filed amendments.

5. SUMMARY OF INVENTION

The present invention relates to improved operability of an information-processing apparatus and usability of application programs and to implement rendering of services to download application programs from a server to the information-processing apparatus. If storage means employed in the information-processing apparatus does not contain

a free area with a storage capacity able to accommodate a desired application program and a relevant data file to be downloaded from the server, the information-processing apparatus and the server automatically transfers application programs and data files from the storage means to an external recording medium such as the server itself in order to secure a free storage area in the storage means.

6. ISSUES

The issue is whether claims 1-19 are unpatentable under 35 U.S.C. §103(a) over Chen in view of Kanevsky in further view of Kuwamoto.

7. GROUPING OF CLAIMS

Claims 1-19 stand or fall together.

8. ARGUMENT

Appellant respectfully submits that the rejection is inappropriate because the combination does not teach or suggest the claimed invention and the combination is improper because it lacks motivation.

A. Combination does not teach or suggest the claimed invention

Appellant's invention, as recited in the independent claims, is directed toward an information-processing apparatus, a server, an information communication system, an information-processing method, an information providing medium, an information-processing program and an information-providing program. Each of the claims recites "an application

program or a data file ... having a smallest activation count.” Supporting disclosure can be found in the specification at, for example, page 37, lines 4-15.

Specifically, claim 1 recites, *inter alia*:

“...but if said storage means has no free storage area left in which said application program is allowed to be installed, an application program or a data file stored in said storage means having a smallest activation count is saved to an external recording medium by way of said communication means in order to allocate a free storage area in said storage means and then said application program transmitted from said server is installed in said storage means.” (emphasis added)

The Office Action relies on Kuwamoto to provide a description of this feature. However, Appellant submits that Kuwamoto does not disclose the above-identified feature of claim 1. Indeed, Kuwamoto, rather than providing any teaching of the claimed feature of saving to an external recording medium, teaches away from the claimed invention by describing deleting material.

Specifically, Kuwamoto discloses,

“[i]n the process 903 of the word processor 201, the print program file 700 is produced from the print program 720 in the memory 11 and transmitted to the print server 202. In the processes 1104 and 1107 to receive the print program file 700, when an area in the Hard disc drive device 26 to store the print program file 700 isn't enough (steps 1109, 1110), the print program file 700 whose use frequency is the smallest is deleted by an automatic deleting process 1900.” (See Kuwamoto col. 12, lines 50-54, emphasis added)

Therefore, since the art used as a basis of rejection fails to describe the features, Appellant submits that the rejection must be withdrawn.

B. The combination of references is improper

Thus, not only does the combination of references fail to teach or suggest the claimed features, the combination of Chen, Kanevsky and Kuwamoto is improper. Appellant traverses the combination of Chen, Kanevsky, and Kuwamoto as a basis of rejection and submits that the combination is improper.

It is not proper to engage in a hindsight reconstruction of the claimed invention using Appellant's structure as a template and selecting elements from references to fill in the gaps. Appellant submits that the combination of Chen, Kanevsky, and Kuwamoto is based on impermissible hindsight. Furthermore, it is well settled that prior art may not be gathered with the claimed invention in mind. See, *Patentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985).

Appellant submits that one of ordinary skill in the art would not reasonably have been motivated to combine a system for installing an application on a portable computer, as disclosed in Chen, with a non-intrusive automatic remote support for freeing overloaded storage, as disclosed in Kanevsky. It is an even larger stretch to further combine Chen and Kanevsky with a word processing apparatus and a printer, as disclosed in Kuwamoto.

Appellant respectfully disagrees with the motivation provided in the Office Action, since there is no specific motivation provided in Chen. Appellant respectfully submits that the Office Action used the claimed invention as a blueprint in an attempt to create a mosaic of features. Thus, Appellant submits that the combination of Chen, Kanevsky, and Kuwamoto is improper and respectfully requests that the rejections based on that combination be withdrawn.

In summary, one of ordinary skill in the art would not have been motivated to look to Chen and/or Kanevsky in light of Kuwamoto since the system described in Kuwamoto is

completely unrelated to the systems described in Chen and Kanevsky. Therefore, Appellant submits that the combination is improper.

Therefore, for the reasons stated above, Appellant respectfully submits that the independent claims are patentable.

The other dependent claims in this application, stand or fall with the independent claims.

C. Response to double patenting rejection

Appellant submits herewith a Terminal Disclaimer, thereby obviating the double patenting rejection.

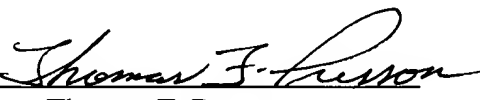
9. CONCLUSION

For the above-stated reasons, pending claims 1-19 are patentable. Appellant respectfully requests early and favorable action.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

Respectfully submitted,

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9. APPENDIX I: CLAIMS ON APPEAL

1. (Previously Presented) An information-processing apparatus comprising:
storage means for storing application programs and data files;
processing means for activating an application program stored in said storage
means to carry out required processing;
communication means for communicating data with an external server; and
control means for controlling said communication means and said storage means;
wherein said control means controls said communication means and said storage
means in such a manner that when an application program is downloaded from said server
connected by said communication means, if said storage means has a free storage area left in
which said application program is allowed to be installed, said application program downloaded
from said server is installed in said storage means; but if said storage means has no free storage
area left in which said application program is allowed to be installed, an application program or a
data file stored in said storage means having a smallest activation count is saved to an external
recording medium by way of said communication means in order to allocate a free storage area
in said storage means and then said application program transmitted from said server is installed
in said storage means.

2. (Original) The information-processing apparatus according to claim 1,
further comprising:
activation-history management means for storing information on an activation
history for each application program and for updating said information on an activation history

for a specific application program upon activation of said specific application program by said processing means;

wherein said control means selects an application program to be saved to said external recording medium on the basis of said information on an activation history.

3. (Original) The information-processing apparatus according to claim 1, wherein said storage means is a non-volatile storage area.

4. (Original) The information-processing apparatus according to claim 1, wherein if an application program or a data file saved in said external recording medium exists at completion of use of an active application program downloaded from said server, said control means controls operations carried out by said communication means and said storage means to delete said active application program from said storage means in order to restore said saved application program or saved said data file from said external recording medium to said storage means by way of said communication means.

5. (Original) The information-processing apparatus according to claim 1, wherein said processing means activates an application program upon installation of said application program downloaded from said server into said storage means.

6. (Previously Presented) A server comprising:
communication means for carrying out communications of data;

downloaded-data storage means for storing a variety of application programs to be downloaded;

saved-data storage means; and

control means for controlling said communication means, said downloaded-data storage means, and said saved-data storage means;

wherein when said server receives a download request from an information processing apparatus connected to said server via said communicating means for carrying out communications of data, said control means transmits an application program stored in said downloaded-data storage means to said information processing apparatus, and when said server receives a saving request from said information apparatus, said control means stores an application program or a data file transmitted from said information processing apparatus in said saved-data storage means as saved data; and

wherein when a storage means in said information processing apparatus has no free storage area left in which one or more of said application programs are allowed to be installed, an application program or a data file stored in said storage means having a smallest activation count is saved to an external recording medium by way of said communication means in order to allocate a free storage area in said storage means and then said application program transmitted from said server is installed in said storage means.

7. (Original) The server according to claim 6, further comprising charging means for carrying out a charging process to request the user of said information-processing apparatus to pay a cost required for a process of transmitting an application program on the basis of the download request made by said information-processing apparatus, and a cost required for

storing an application program or a data file on the basis of the saving request made by said information-processing apparatus.

8. (Previously Presented) An information communication system including an information-processing apparatus and a server connected to said information-processing apparatus in a state of being able to exchange data with said information-processing apparatus, said information-processing apparatus comprising:

- storage means for storing application programs and data files;
- processing means for activating an application program stored in said storage means to carry out required processing;
- communication means for communicating data with an external server; and
- control means for controlling said communication means and said storage means;

wherein said control means controls said communication means and said storage means in such a manner that when an application program is downloaded from said server connected by said communication means, if said storage means has a free storage area left in which said application program is allowed to be installed, said application program downloaded from said server is installed in said storage means; but if said storage means has no free storage area left in which said application program is allowed to be installed, an application program or a data file stored in said storage means having a smallest activation count is saved to an external recording medium by way of said communication means in order to allocate a free storage area in said storage means and then said application program transmitted from said server is installed in said storage means,

said server comprising:

communication means for carrying out communications of data;

downloaded-data storage means for storing a variety of application programs to be downloaded;

saved-data storage means; and

control means for controlling said communication means, said downloaded-data storage means, and said saved-data storage means;

wherein when said server receives a download request from an information processing apparatus connected to said server via said communicating means for carrying out communications of data, said control means transmits an application program stored in said downloaded-data storage means to said information processing apparatus, and when said server receives a saving request from said information apparatus, said control means stores an application program or a data file transmitted from said information processing apparatus in said saved-data storage means as saved data.

9. (Original) The information communication system according to claim 8, further comprising charging means for carrying out a charging process to request the user of said information-processing apparatus to pay a cost required for a process of transmitting an application program on the basis of the download request made by said information-processing apparatus, and a cost required for storing an application program or a data file on the basis of the saving request made by said information-processing apparatus.

10. (Previously Presented) An information-processing method comprising the steps of:

storing application programs and data files in a storing means;

activating an application program stored in said storage means to carry out required processing by a processing means;

communicating data with an external server by way of a communication means;

and

controlling said communication means and said storage means by a control means;

wherein said control means controls said communication means and said storage means in such a manner that when an application program is downloaded from said server connected by said communication means, if said storage means has a free storage area left in which said application program is allowed to be installed, said application program downloaded from said server is installed in said storage means; but if said storage means has no free storage area left in which said application program is allowed to be installed, an application program or a data file stored in said storage means having a smallest activation count is saved to an external recording medium by way of said communication means in order to allocate a free storage area in said storage means and then said application program transmitted from said server is installed in said storage means.

11. Original) e information-processing method according to claim 10, further comprising the step of:

storing information on an activation history for each application program and updating said information on an activation history for a specific application program upon activation of said specific application program by said processing means;

wherein said control means selects an application program to be saved to said external recording medium on the basis of said information on an activation history.

12. (Original) The information-processing method according to claim 10, wherein if an application program or a data file saved in said external recording medium exists at completion of use of an active application program downloaded from said server, said control means controls operations carried out by said communication means and said storage means to delete said active application program from said storage means in order to restore said saved application program or saved said data file from said external recording medium to said storage means by way of said communication means.

13. (Previously Presented) An information providing method comprising the steps of:

carrying out communications of data by way of a communication means;

storing a variety of application programs to be downloaded in a downloaded-data storage means;

controlling said communication means, said downloaded-data storage means, and a saved-data storage means;

wherein when a download request from an information processing apparatus connected to a server via said communicating means is received, said control means transmits an application program stored in said downloaded-data storage means to said information processing apparatus, and when a saving request from said information apparatus is received,

said control means stores an application program or a data file transmitted from said information processing apparatus in said saved-data storage means as saved data; and

wherein when a storage means in said information processing apparatus has no free storage area left in which one or more of said application programs are allowed to be installed, an application program or a data file stored in said storage means having a smallest activation count is saved to an external recording medium by way of said communication means in order to allocate a free storage area in said storage means and then said application program transmitted from said server is installed in said storage means.

14. (Original) The information providing method according to claim 13, further comprising the step of carrying out a charging process to request the user of said information-processing apparatus to pay a cost required for a process of transmitting an application program on the basis of the download request made by said information-processing apparatus, and a cost required for storing an application program or a data file on the basis of the saving request made by said information-processing apparatus.

15. (Previously Presented) A computer readable storage medium having an information processing program stored therein for the purpose of performing a method of processing information, said method comprising the steps of:

storing application programs and data files in a storing means;

activating an application program stored in said storage means to carry out required processing by a processing means;

communicating data with an external server by way of a communication means;
and

controlling said communication means and said storage means by a control means;

wherein said control means controls said communication means and said storage means in such a manner that when an application program is downloaded from said server connected by said communication means, if said storage means has a free storage area left in which said application program is allowed to be installed, said application program downloaded from said server is installed in said storage means; but if said storage means has no free storage area left in which said application program is allowed to be installed, an application program or a data file stored in said storage means having a smallest activation count is saved to an external recording medium by way of said communication means in order to allocate a free storage area in said storage means and then said application program transmitted from said server is installed in said storage means.

16. (Previously Presented) The storage medium having the information-processing program according to claim 15, further comprising the step of:

storing information on an activation history for each application program and updating said information on an activation history for a specific application program upon activation of said specific application program by said processing means;

wherein said control means selects an application program to be saved to said external recording medium on the basis of said information on an activation history.

17. (Previously Presented) The storage medium having the information-processing program according to claim 15, wherein if an application program or a data file saved in said external recording medium exists at completion of use of an active application program downloaded from said server, said control means controls operations carried out by said communication means and said storage means to delete said active application program from said storage means in order to restore said saved application program or saved said data file from said external recording medium to said storage means by way of said communication means.

18. (Previously Presented) A computer readable storage medium having an information providing program stored therein for the purpose of performing a method of providing information, said method comprising the steps of:

carrying out communications of data by way of a communication means;

storing a variety of application programs to be downloaded in a downloaded-data storage means;

controlling said communication means, said downloaded-data storage means, and a saved-data storage means;

wherein when a download request from an information processing apparatus connected to a server via said communicating means is received, said control means transmits an application program stored in said downloaded-data storage means to said information processing apparatus, and when a saving request from said information apparatus is received, said control means stores an application program or a data file transmitted from said information processing apparatus in said saved-data storage means as saved data; and

wherein when a storage means in said information processing apparatus has no free storage area left in which one or more of said application programs are allowed to be installed, an application program or a data file stored in said storage means having a smallest activation count is saved to an external recording medium by way of said communication means in order to allocate a free storage area in said storage means and then said application program transmitted from said server is installed in said storage means.

19. (Previously Presented) The storage medium having the information providing program according to claim 18, further comprising the step of carrying out a charging process to request the user of said information-processing apparatus to pay a cost required for a process of transmitting an application program on the basis of the download request made by said information-processing apparatus, and a cost required for storing an application program or a data file on the basis of the saving request made by said information-processing apparatus.